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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,686	10/25/2003	Osamu Kimoto	81710.0261	3913
26/021 7590 09/10/2008 HOGAN & HARTSON LLP. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067				
EXAMINER				
TSANG, ELBERT				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/694,686

**Applicant(s)**

KIMOTO, OSAMU

**Examiner**

ELBERT TSANG

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 25 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 5, 7, 9, 11, 13, 15 and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claims 1, 9 and 17 recite, "... the stored image data includes various pieces of information that are not image data..." It is unclear how image data includes information that is not image data. Clarification of claim language is needed.
- b. Claims 1, 9, and 17 also recite, "extracts the various pieces of information directly from the stored image data other than image data included in the stored image data..." It is unclear how information other than image data from image data is extracted from itself. Clarification of claim language is needed.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 1-6, 9-14 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasunobu, US PG Pub No.: 2002/0051259 A1 (hereinafter Yasunobu) in view of Henry, US PG Pub No.: 2003/0020959 A1 (hereinafter Henry).**

Re claim 9, an image transmitting device comprising: a scanner [fig. 2, i.e. scanner 25; para. 0030] that scans an image of a document; a memory [fig. 2, i.e. data storage unit 21; para. 0030] that stores scanned image data; a controller [fig. 2, i.e. communication interface 22; para. 0030] that connects to a communication medium; Yasunobu discloses the image transmitting device. However, Yasunobu does not disclose the stored image data includes various pieces of information that are not image data. Henry discloses extracting facsimile number from an electronic image [para. 0061; examiner views a facsimile number is information other than part of image]. Henry discloses an extracting unit that extracts the various pieces of information directly from the stored image data other than image data included in the stored image data [para. 0061; facsimile number is extracted from electronic image. Henry discloses a converter that converts the extracted various pieces of information into extracted image data and

transmits the extracted image data along with the scanned image data as transmission image data [para. 0061]. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to extract facsimile numbers [non image data] from an electronic image to efficiently convert facsimiles to electronic email as prescribed by Henry [para. 0006].

For claim 11, Yasunobu discloses, the image transmitting device according to claim 9, wherein when transmitting a multiple page image all at once, data regarding a number of pages of the multiple page image is included in the extracted information [para. 0068; i.e. a list of data stored in the data storage unit including number of pages].

For claim 13, Yasunobu discloses, the image transmitting device according to claim 9, wherein the image is of a color original document [para. 0070, i.e. a color flag is set when data is color image data].

Re claims 1, 3 and 5 are means for conducting steps corresponding to apparatus claims 9, 11 and 13. Thus, they have been analyzed and rejected w/r to claims 9, 11 and 13.

Re claims 17-19 are method claims corresponding to apparatus claims of 9, 11 and 13. Thus, they have been analyzed and rejected w/r to claims 9, 11 and 13.

Re claim 10, Yasunobu discloses an image transmitting device comprising: a scanner [fig. 2, i.e. scanner 25; para. 0030] that scans an image of a document; a memory that stores scanned sYCC-Joint Photographic Experts Group (JPEG) image data [fig. 2, i.e. memory card 6; para. 0031, wherein data format is the YCbCr format. The sYCC color space is a particular form of the YCbCr space. It would have been obvious to a person of ordinary skill in the art to interchangeably use sYCC color space when dealing with color images for digital processing [para. 0035] wherein the stored sYCC-JPEG image data includes various pieces of information that are not image data [Yasunobu does not disclose information that is not image data is part of image data, however OFFICIAL NOTICE is taken that JPEG image data includes header information, creation date and time, etc., which is under the limitation of non image data]; a controller [fig. 2, i.e. communication interface 22; para. 0030] that connects to a communication line. Yasunobu discloses the image transmitting device. However Yasunobu does not disclose a extracting unit that extracts the various pieces of information directly from the stored image data other than image data included in the stored sYCC-JPEG color image data; and a converter that converts the extracted various pieces of information into extracted data and transmits the extracted image data along with the scanned SYCC-JPEG image data as transmission image data. Henry discloses an extracting unit that extracts the various pieces of information directly from the stored image data other than image data included in the stored image data [para. 0061; facsimile number is extracted from electronic image. Henry discloses a converter that converts the extracted various pieces of information into extracted image data and

transmits the extracted image data along with the scanned image data as transmission image data [para. 0061]. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to extract facsimile numbers [non image data] from an electronic image to efficiently convert facsimiles to electronic email as prescribed by Henry [para. 0006].

For claim 12, the image transmitting device according to claim 10, wherein when transmitting a multiple page image all at once, data regarding a number of pages of the multiple page image is included in the extracted information [para. 0068; i.e. a list of data stored in the data storage unit including number of pages].

For claim 14, the image transmitting device according to claim 10, wherein the image is of a color original document [para. 0070, i.e. a color flag is set when data is color image data].

Re claims 2, 4 and 6 are means for conducting steps corresponding to apparatus claims 10, 12 and 14. Thus, they have been analyzed and rejected w/r to claims 10, 12 and 14.

**5. Claims 7, 8, 15, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasunobu in view of Henry as applied to claims 1-6, 9-14 and**

**17-19 above, further in view of Ishii US PG Pub No.: 2002/0097449 A1 (hereinafter Ishii).**

For claim 7, Yasunobu and Henry do not disclose, the image transmitting device according to claim 1, wherein the image data includes a photographed time, however Ishii does [para. 0008, wherein images are embedded with marks such as copyrights, logos and serial numbers; time stamps are obvious variants of these markings]. Yasunobu discloses using a digital still camera [para. 0003] as an image input device into personal computers which use various memory cards as a means for storing still images. It would have been obvious to a person of ordinary skill in the art when processing image data, such as images from a digital camera, an associated date and time stamp is incorporated into the image data].

Claims 8, 15, 16 and 20 have been analyzed and rejected w/r to claim 7 above.

### ***Contact***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELBERT TSANG whose telephone number is (571)270-3748. The examiner can normally be reached on 8:00 AM - 5:00 PM, M-F, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark K. Zimmerman can be reached on (571) 272-7653. The fax phone



number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ELBERT TSANG/  
Examiner, Art Unit 2625

/Mark K Zimmerman/  
Supervisory Patent Examiner, Art Unit 2625